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In re Application of
DAMRAU et al.
Application No.: 10/532,523
PCT No.: PCT/EP03/11679
Int. Filing Date: 22 October 2003
Priority Date: 25 October 2002
Attorney Docket No.: 09086-00223-US
For: PREPARATION OF PARTIALLY
HYDROGENATED RAC-ANSA-
METALLOCENE COMPLEXES

DECISION ON
PETITION UNDER
37 CFR 1.47(a)

This is a decision on applicants' transmittal of Combined Declaration and Power of Attorney executed by joint inventor Stephanie Duchiron and filed on 23 March 2006 in the United States Patent and Trademark Office (USPTO), in response to a decision on petition under 37 CFR 1.47(a). This is also responsive to applicant's submission on 22 August 2006 accompanied by a copy of the declaration allegedly submitted with the petition under 37 CFR 1.47(a) on 15 September 2005.

BACKGROUND

On 15 September 2005, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, the surcharge under 37 CFR 1.492(e) and a statement of facts by Renate Timmler.

On 23 January 2006, a decision dismissing the petition under 37 CFR 1.47(a) was mailed, indicating that applicant had not demonstrated a diligent effort to locate the nonsigning inventor. Applicant was also advised that an executed declaration, signed on behalf of the joint inventors and the nonsigning inventor, was not found among the papers submitted on 15 September 2005.

On 23 March 2006, applicant submitted a declaration executed by the previously nonsigning inventor Stephanie Duchiron. In response to a telephone call from the undersigned, on 22 August 2006, applicant provided a copy of the declaration, which was executed by six of seven joint inventors.

DISCUSSION

The petition under 37 CFR 1.47(a) is now considered moot as a declaration signed by a previously nonsigning inventor Stephanie Duchiron was submitted. However, the declarations submitted on 23 March and 22 August 2006 are not in compliance with 37 CFR 1.497(a) and (b) and are unacceptable for the following reasons. The declaration, submitted on 23 March 2006, is signed only by Stephanie Duchiron and is unacceptable because it does not identify all inventors; that is, it does not identify Hans-Robert Hellmuth Damrau, the first named inventor on the published international application.¹ The declaration is not in compliance with 37 CFR 1.497(a) and (b).

With regard to the declaration submitted via facsimile on 22 August 2006, the declaration does not properly identify joint inventors as listed on the published international application. The first unnumbered signature sheet, bearing the signature of Hans-Robert-Hellmuth Damrau, identifies him as the *sole* inventor and does not identify any of the remaining joint inventors. The spaces on that signature sheet, naming the "SECOND JOINT INVENTOR", "THIRD JOINT INVENTOR", "FOURTH JOINT INVENTOR", "FIFTH JOINT INVENTOR", and "SIXTH JOINT INVENTOR", are all blank and do not identify any joint inventors. The third unnumbered sheet attached to this declaration is executed and identifies Patrick Muller as "FIRST JOINT INVENTOR", Valerie Garcia as the "SECOND JOINT INVENTOR", Christian Sidot as the "THIRD JOINT INVENTOR", Christian Tellier as the "FOURTH JOINT INVENTOR", Stephanie Duchiron as the "FIFTH JOINT INVENTOR", and Jean-Francois Lelong as the "SIXTH JOINT INVENTOR". The signature page for Mr. Damrau appears to be inserted and is considered an alteration to the declaration. It appears that inventors Muller, Garcia, Sidot, Tellier, Duchiron and Lelong were not apprised of Mr. Damrau's inventorship nor he of their joint inventorship.

The USPTO does not accept a declaration that has been altered. Section 602.01 of the MPEP states the following:

The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration must be required....

Thus, both declarations are unacceptable and are not a proper response to the 23 January 2006 decision. The declarations do not properly identify all the inventors as required by 37 CFR 1.497(a) and (b).

¹ Applicant does not contend and has not provided an Notification of the Recording of A Change (Form PCT/IB/306) issued by the International Bureau removing Hans-Robert Hellmuth Damrau as a co-inventor under PCT Rule 92bis.

CONCLUSION

For the above reasons set forth above, the declarations, submitted on 23 March and 22 August 2006, are unacceptable and do not meet the requirements of 37 CFR 1.497(a) and (b).

A proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to provide a proper reply, that is, a newly executed declaration, will result in abandonment of the application.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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